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UNITED STATES DISTRICT COURT

DISTRICT OF NEVADA

UNWIRED PLANET LLC, a Nevada
limited liability company,

Plaintiff,

vs.

APPLE INC., a California corporation,

Defendant.

Case No. 3:12-cv-00505-RCJ-VPC

**ANSWER TO COMPLAINT FOR
PATENT INFRINGEMENT,
AFFIRMATIVE AND OTHER
DEFENSES, AND COUNTERCLAIM**

(JURY DEMAND)

1 **ANSWER TO COMPLAINT FOR PATENT INFRINGEMENT**

2 Defendant Apple Inc. (“Apple”), by and through its attorneys, hereby responds
3 to Unwired Planet LLC’s (“Unwired Planet’s”) Complaint for Patent Infringement.
4 Apple denies each and every allegation in the Complaint, except as specifically
5 admitted herein. The responses below reflect only the current status of Apple’s
6 knowledge and belief regarding the subject matter of the allegations to which they
7 respond and are subject to additional or different information that may be discovered
8 during the course of this proceeding. The headings below track those used in the
9 Complaint and are for convenience only. They do not constitute any part of Apple’s
10 Answer to the Complaint or any admission by Apple as to the truth of the matters
11 asserted.

12 **JURISDICTION**

13 1. Apple admits that Unwired Planet purports to bring this action as one
14 arising under the patent law of the United States, 35 U.S.C. § 101 *et seq.* Apple admits
15 that this Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

16 **VENUE**

17 2. For the purposes of this action, Apple does not challenge the personal
18 jurisdiction of this Court over Apple. Apple admits for the purposes of this action that
19 it has conducted and does conduct business within the State of Nevada. Apple admits
20 for the purposes of this action that it, directly or through subsidiaries or intermediaries,
21 ships, distributes, offers for sale, sells, and advertises products and/or services in the
22 United States, the State of Nevada, and the District of Nevada. Apple denies that any
23 of its products infringe any patent asserted by Unwired Planet. But, for the purposes of
24 this action, Apple admits that it, directly or through subsidiaries or intermediaries, has
25 placed one or more of the products and/or services that are alleged by Unwired Planet
26 to infringe one or more of the Asserted Patents into the stream of commerce. Apple
27 admits that it has done so with the expectation that such products and/or services will
28 be purchased and/or used by consumers in the District of Nevada, and that such

1 products and/or services have been and continue to be purchased and/or used by
2 consumers in the District of Nevada. Apple denies the remaining allegations in
3 Paragraph 2 of the Complaint.

4 3. For purposes of this action, Apple does not challenge that venue is proper
5 in this judicial district. Apple denies that a substantial part of the events giving rise to
6 Unwired Planet's claims occurred in the District of Nevada.

7 **PARTIES**

8 4. Apple lacks knowledge or information sufficient to form a belief as to the
9 truth of the allegations of Paragraph 4 of the Complaint and therefore denies these
10 allegations.

11 5. Denied.

12 6. Apple admits that it is a corporation organized under the laws of
13 California, and that its principal place of business is located at 1 Infinite Loop,
14 Cupertino, California 95014-2083.

15 7. Apple admits that it makes, uses, imports into the United States, sells or
16 offers to sell in the United States, various systems or services, servers, and mobile
17 devices, including within this judicial district. Apple admits that it can be served with
18 process by serving its registered agent in Nevada, The Corporation Trust Company of
19 Nevada, located at 311 S. Division Street, Carson City, Nevada 89703.

20 **BACKGROUND**

21 8. Apple lacks knowledge or information sufficient to form a belief as to the
22 truth of the allegation that Unwired Planet was founded in 1994 and therefore denies
23 this allegation. Apple denies the remaining allegations in Paragraph 8 of the
24 Complaint.

25 9. Apple denies that Unwired Planet was the first to put an internet browser
26 into a phone. Apple further denies Unwired Planet's allegation that "[w]hile Unwired
27 Planet saw the need for applications and environments that could leverage emerging
28 devices and increasing bandwidth, other technology firms were too focused on their

1 old way of doing business.” Apple lacks knowledge or information sufficient to form
2 a belief as to the truth of the remaining allegations in Paragraph 9 of the Complaint,
3 and therefore denies these allegations.

4 10. Apple lacks knowledge or information sufficient to form a belief as to the
5 truth of the allegations in Paragraph 10 of the Complaint, and therefore denies these
6 allegations.

7 11. Apple admits that Unwired Planet’s predecessor sold and offered for sale
8 products including products titled “UP.Mail” and “UP.Browser.” Apple lacks
9 knowledge or information sufficient to form a belief as to the truth of the remaining
10 allegations in Paragraph 11 of the Complaint, and therefore denies these allegations.

11 12. Apple lacks knowledge or information sufficient to form a belief as to the
12 truth of the allegations in Paragraph 12 of the Complaint, and therefore denies these
13 allegations.

14 13. Denied.

15 14. Apple admits that in or around April 2012 Openwave Systems Inc. sold
16 its product businesses. Apple lacks knowledge or information sufficient to form a
17 belief as to the truth of the remaining allegations in Paragraph 14 of the Complaint,
18 and therefore denies these allegations.

19 **THE PATENTS**

20 15. Apple admits that United States Letters Patent No. 6,317,594 (“the ’594
21 Patent”), is entitled “System and Method for Providing Data to a Wireless Device upon
22 Detection of Activity of the Device on a Wireless Network,” lists William E. Gossman
23 and Peter J. Hartmaier as the inventors, and lists as its issue date November 13, 2001.
24 Apple admits that what purports to be a true and correct copy of the ’594 Patent is
25 attached as Exhibit A to the Complaint. Apple denies that the ’594 Patent was duly
26 and legally issued, and denies that Unwired Planet is entitled to sue for past and future
27 infringement. Apple lacks knowledge or information sufficient to form a belief as to
28 the truth of the remaining allegations in Paragraph 15 of the Complaint, and therefore

1 denies these allegations.

2 16. Apple admits that United States Letters Patent No. 6,317,831 (“the ’831
3 Patent”), is entitled “Method and Apparatus for Establishing a Secure Connection over
4 a One-way Data Path,” lists Peter F. King as the inventor, and lists as its issue date
5 November 13, 2001. Apple admits that what purports to be a true and correct copy of
6 the ’831 Patent is attached as Exhibit B to the Complaint. Apple denies that the ’831
7 Patent was duly and legally issued, and denies that Unwired Planet is entitled to sue for
8 past and future infringement. Apple lacks knowledge or information sufficient to form
9 a belief as to the truth of the remaining allegations in Paragraph 16 of the Complaint,
10 and therefore denies these allegations.

11 17. Apple admits that United States Letters Patent No. 6,321,092 (“the ’092
12 Patent”), is entitled “Multiple Input Data Management for Wireless Location-based
13 Applications,” lists James Fitch, David L. Hose, and Michael McKnight as the
14 inventors, and lists as its issue date November 20, 2001. Apple admits that what
15 purports to be a true and correct copy of the ’092 Patent is attached as Exhibit C to the
16 Complaint. Apple denies that the ’092 Patent was duly and legally issued, and denies
17 that Unwired Planet is entitled to sue for past and future infringement. Apple lacks
18 knowledge or information sufficient to form a belief as to the truth of the remaining
19 allegations in Paragraph 17 of the Complaint, and therefore denies these allegations.

20 18. Apple admits that United States Letters Patent No. 6,532,446 (“the ’446
21 Patent”), is entitled “Server Based Speech Recognition User Interface for Wireless
22 Devices,” lists Peter F. King as the inventor, and lists as its issue date March 11, 2003.
23 Apple admits that what purports to be a true and correct copy of the ’446 Patent is
24 attached as Exhibit D to the Complaint. Apple denies that the ’446 Patent was duly
25 and legally issued, and denies that Unwired Planet is entitled to sue for past and future
26 infringement. Apple lacks knowledge or information sufficient to form a belief as to
27 the truth of the remaining allegations in Paragraph 18 of the Complaint, and therefore
28 denies these allegations.

1 19. Apple admits that United States Letters Patent No. 6,647,260 (“the ’260
2 Patent”), is entitled “Method and System Facilitating Web Based Provisioning of Two-
3 Way Mobile Communications Devices,” lists Steve Dusse, Peter F. King, Bruce V.
4 Schwartz, and Bruce K. Martin, Jr. as the inventors, and lists as its issue date
5 November 11, 2003. Apple admits that what purports to be a true and correct copy of
6 the ’260 Patent is attached as Exhibit E to the Complaint. Apple denies that the ’260
7 Patent was duly and legally issued, and denies that Unwired Planet is entitled to sue for
8 past and future infringement. Apple lacks knowledge or information sufficient to form
9 a belief as to the truth of the remaining allegations in Paragraph 19 of the Complaint,
10 and therefore denies these allegations.

11 20. Apple admits that United States Letters Patent No. 6,813,491 (“the ’491
12 Patent”), is entitled “Method and Apparatus for Adapting Settings of Wireless
13 Communication Devices in Accordance with User Proximity,” lists Aldan Martin
14 McKinney as the inventor, and lists as its issue date November 2, 2004. Apple admits
15 that what purports to be a true and correct copy of the ’491 Patent is attached as
16 Exhibit F to the Complaint. Apple denies that the ’491 Patent was duly and legally
17 issued, and denies that Unwired Planet is entitled to sue for past and future
18 infringement. Apple lacks knowledge or information sufficient to form a belief as to
19 the truth of the remaining allegations in Paragraph 20 of the Complaint, and therefore
20 denies these allegations.

21 21. Apple admits that United States Letters Patent No. 7,020,685 (“the ’685
22 Patent”), is entitled “Method and Apparatus for Providing Internet Content to SMS-
23 based Wireless Devices,” lists David A. Chen and Piyush Patel as the inventors, and
24 lists as its issue date March 28, 2006. Apple admits that what purports to be a true and
25 correct copy of the ’685 Patent is attached as Exhibit G to the Complaint. Apple
26 denies that the ’685 Patent was duly and legally issued, and denies that Unwired Planet
27 is entitled to sue for past and future infringement. Apple lacks knowledge or
28 information sufficient to form a belief as to the truth of the remaining allegations in

1 Paragraph 21 of the Complaint, and therefore denies these allegations.

2 22. Apple admits that United States Letters Patent No. 7,233,790 (“the ’790
3 Patent”), is entitled “Device Capability Based Discovery, Packaging and Provisioning
4 of Content for Wireless Mobile Devices,” lists Rikard M. Kjellberg, Sheng Liang,
5 Tomas G. Lund, William Chan, Ramakrishna Chinta, and Xinbi Chen as the inventors,
6 and lists as its issue date June 19, 2007. Apple admits that what purports to be a true
7 and correct copy of the ’790 Patent is attached as Exhibit H to the Complaint. Apple
8 denies that the ’790 Patent was duly and legally issued, and denies that Unwired Planet
9 is entitled to sue for past and future infringement. Apple lacks knowledge or
10 information sufficient to form a belief as to the truth of the remaining allegations in
11 Paragraph 22 of the Complaint, and therefore denies these allegations.

12 23. Apple admits that United States Letters Patent No. 7,299,033 (“the ’033
13 Patent”), is entitled “Domain-Based Management of Distribution of Digital Content
14 from Multiple Suppliers to Multiple Wireless Services Subscribers,” lists Rikard M.
15 Kjellberg, Sheng Liang, Tomas G. Lund, and William Chan as the inventors, and lists
16 as its issue date November 20, 2007. Apple admits that what purports to be a true and
17 correct copy of the ’033 Patent is attached as Exhibit I to the Complaint. Apple denies
18 that the ’033 Patent was duly and legally issued, and denies that Unwired Planet is
19 entitled to sue for past and future infringement. Apple lacks knowledge or information
20 sufficient to form a belief as to the truth of the remaining allegations in Paragraph 23
21 of the Complaint, and therefore denies these allegations.

22 24. Apple admits that United States Letters Patent No. 7,522,927 (“the ’927
23 Patent”), is entitled “Interface for Wireless Location Information,” lists James Fitch,
24 David Hose, and Michael McKnight as the inventors, and lists as its issue date April
25 21, 2009. Apple admits that what purports to be a true and correct copy of the ’927
26 Patent is attached as Exhibit J to the Complaint. Apple denies that the ’927 Patent was
27 duly and legally issued, and denies that Unwired Planet is entitled to sue for past and
28 future infringement. Apple lacks knowledge or information sufficient to form a belief

1 as to the truth of the remaining allegations in Paragraph 24 of the Complaint, and
2 therefore denies these allegations.

3 25. Denied.

4 **CLAIM FOR PATENT INFRINGEMENT**

5 26. No response is required to Unwired Planet's incorporation by reference of
6 paragraphs 1-25 of its Complaint. To the extent a response is deemed required, Apple
7 incorporates by reference its responses in Answer to Paragraphs 1-25, above.

8 27. Denied.

9 28. Denied.

10 29. Denied.

11 30. Denied.

12 31. Denied.

13 **DEMAND FOR JURY TRIAL**

14 A response is not required to Unwired Planet's demand for a trial by jury. To
15 the extent that a response is deemed required, Apple requests a trial by jury pursuant to
16 Rule 38 of the Federal Rules of Civil Procedure.

17 **PRAYER FOR RELIEF**

18 A response is not required to Unwired Planet's prayer for relief. To the extent
19 that a response is deemed required, Apple denies that Unwired Planet is entitled to any
20 relief whatsoever. Apple has not infringed, directly or indirectly, any valid and
21 enforceable claim of the Asserted Patents, and Unwired Planet is not entitled to any
22 remedy or recovery. Unwired Planet's prayer should therefore be denied in its entirety
23 and with prejudice, and Unwired Planet should take nothing.

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1 **AFFIRMATIVE AND OTHER DEFENSES**

2 Further answering the Complaint and as additional answers thereto, Apple
3 asserts the following affirmative and other defenses:

4 **FIRST DEFENSE – INVALIDITY**

5 1. One or more of the claims of the Asserted Patents are invalid and
6 unpatentable under 35 U.S.C. § 101 at least because the claims fail to satisfy the
7 conditions and requirements for patentability under Title 35 of the United States Code,
8 and are not directed to a new and useful process, machine, manufacture, or
9 composition of matter, or any new and useful improvements thereof. One or more
10 claims of the Asserted Patents are invalid under 35 U.S.C. §§ 102(a), 102(b), 102(c),
11 102(d), 102(e), 102(f), 102(g) and 103, because each element of one or more such
12 claims is disclosed in prior art references and systems, considered alone or in
13 combination with other references and systems, and because one or more of the named
14 inventors did not invent the subject matter sought to be patented. Such prior art
15 references include, but are not limited to, the prior art referenced during prosecution of
16 the applications for the Asserted Patents and in related patent applications. One or
17 more of the claims of the Asserted Patents are invalid under 35 U.S.C. § 112(a) at least
18 because the Asserted Patents fail to provide a written description that conveys with
19 reasonable clarity to those skilled in the art that, as of the filing dates sought, the
20 inventors of the Asserted Patents were in possession of the invention, and because the
21 Asserted Patents fail to enable any person reasonably skilled in the art to make and use
22 the alleged invention claimed therein. One or more of the claims of the Asserted
23 Patents are invalid as indefinite under 35 U.S.C. § 112(b) for failing to particularly
24 point out and distinctly claim the subject matter of the invention claimed therein.

25 **SECOND DEFENSE – NON-INFRINGEMENT**

26 2. Apple has not infringed and does not infringe any valid and enforceable
27 claim of the Asserted Patents, directly or indirectly, literally or under the doctrine of
28 equivalents.

THIRD DEFENSE – LACHES/ESTOPPEL/WAIVER

3. Unwired Planet’s claims for relief are barred in whole or in part by the equitable doctrines of laches, estoppel, and/or waiver.

FOURTH DEFENSE – LIMITATION OF DAMAGES

4. Unwired Planet’s claim for damages is limited by 35 U.S.C. § 286.

FIFTH DEFENSE – NO NOTICE

5. To the extent Unwired Planet seeks damages for any alleged infringement occurring prior to its giving actual notice of the alleged infringement of the Asserted Patents to Apple, its claims are barred pursuant to 35 U.S.C. § 287.

SIXTH DEFENSE – LICENSE/PATENT EXHAUSTION

6. Unwired Planet’s claims are barred, in whole or in part, to the extent Apple has an express and/or implied license under one or more of the Patents-in-Suit and/or by the doctrine of patent exhaustion.

SEVENTH DEFENSE – COSTS BARRED

7. Unwired Planet is barred from recovering costs in connection with this action under 35 U.S.C. § 288.

EIGHTH DEFENSE – FAILURE TO STATE A CLAIM

8. The Complaint fails to state any claim against Apple upon which relief can be granted.

NINTH DEFENSE – INEQUITABLE CONDUCT

9. Each of the following patents is unenforceable because in each case individuals associated with prosecution of the patent committed inequitable conduct in its procurement. The following analysis is based on Unwired Planet’s apparent interpretation of the scope of the claims of these patents, as evidenced by Unwired Planet’s Complaint, and is not necessarily based on any claim construction positions that may be advanced by Apple.

U.S. Patent No. 7,299,033

10. During prosecution of the ’033 Patent, individuals associated with the

1 prosecution of the '033 Patent withheld material, non-cumulative prior art from the
2 patent examiner with intent to deceive the United States Patent and Trademark Office
3 ("USPTO"), and furthermore made affirmative misrepresentations of material facts
4 with the intent to deceive the USPTO. The withheld material, non-cumulative prior
5 art included Unwired Planet's own commercial activity, as well as that of its
6 predecessor-in-interest, and printed publications relating to that activity, as described
7 below.

8 11. The '033 Patent states on its face that it issued from U.S. Patent
9 Application No. 10/601,022, filed on June 19, 2003. The '033 Patent also states that it
10 is related to Provisional Application Nos. 60/393,024, 60/392,383, 60/393,041, and
11 60/392,999, all filed on June 28, 2002.

12 12. The '033 Patent on its face, and at all times during its prosecution, claims
13 a "plurality of domains" where "each of the domains [are] assigned thereto to a
14 particular set of digital products designed for use in wireless communication devices
15 that are accessible to the wireless services subscribers in that domain."

16 13. On or around May 29, 2002, Unwired Planet's predecessor Openwave
17 Systems, Inc. acquired a company called Ellipsus Systems, Inc. ("Ellipsus").

18 14. On information and belief, Ellipsus was founded originally by Rikard M.
19 Kjellberg, the first named inventor of the '033 Patent.

20 15. On information and belief, more than one year before June 28, 2002,
21 Ellipsus released three products related to mobile applications: infiniteMAP,
22 infiniteMASS, and Enterprise Application Adapters ("EAA") (combined, the "Ellipsus
23 Products").

24 16. On information and belief, on or around February 12, 2001, Ellipsus
25 published white papers describing each of the Ellipsus Products. On information and
26 belief, more than one year before June 28, 2002, Ellipsus published user manuals,
27 technical support documents, and other documents describing the Ellipsus Products.

28 17. The only Ellipsus-published document before the examiner of the '033

1 Patent was a 10-page white paper describing the infiniteMAP product (“infiniteMAP
2 white paper”). Exhibit 4. White papers describing infiniteMASS and EAA (Exhibits 1
3 and 2, respectively), on which Mr. Kjellberg was a co-author, were never identified or
4 provided to the examiner. Nor were any other documents describing the Ellipsus
5 Products, including user manuals or technical support documents, identified or
6 provided to the examiner.

7 18. On June 28, 2005, the examiner of the '033 Patent rejected the application
8 as being anticipated by the infiniteMAP white paper. The infiniteMAP white paper
9 had not been disclosed by Unwired Planet to the examiner. Instead, the examiner had
10 independently located the prior art reference in a November 22, 2004 Information
11 Disclosure Statement filed by Unwired Planet in a co-pending application that was
12 later issued as the '790 Patent. The co-pending application was not cross-referenced in
13 the '033 Patent application.

14 19. The examiner explained in his rejection that the infiniteMAP white paper
15 disclosed a “plurality of domains,” because “it is inherent that there would be multiple
16 domains based on different devices capabilities and user profiles.” Office Action dated
17 June 28, 2005.

18 20. The examiner further stated that “[i]n view of the inability of the
19 Examiner to obtain any additional Ellipsus information, as the company has been
20 acquired by the current assignee, Openwave Systems Inc., the Examiner is requesting
21 any additional information that Applicants may have access to that would be material
22 to the examination of the application.” *Id.*

23 21. On September 30, 2005, in response to the examiner’s request for
24 additional information, the applicants for the '033 Patent, including Mr. Kjellberg,
25 stated that they were “not aware of any other information that may be material to the
26 examination of this application, other than the materials which have already been cited
27 and the materials which are being cited concurrently with the filing of this
28 amendment.” Amendment dated September 30, 2005.

22. On information and belief, Mr. Kjellberg, the founder of Ellipsus and first named inventor on the '033 Patent, was aware that other documents regarding the Ellipsus Products existed, including white papers describing infiniteMASS and EAA (Exhibits 1 and 2, respectively), of which Mr. Kjellberg was a co-author, and further including user manuals, technical support documents, and other documents describing the Ellipsus Products in Unwired Planet's possession. On information and belief, Mr. Kjellberg further knew that the withheld art plainly disclosed a "plurality of domains." Mr. Kjellberg's statement in the September 30, 2005 Amendment therefore was an affirmative misrepresentation of material fact made with intent to deceive the USPTO.

23. The examiner issued two more rejections of the application as being anticipated by the infiniteMAP white paper, on December 20, 2005, and May 5, 2006, for the reason that the infiniteMAP white paper inherently discloses a "plurality of domains."

24. In traversing both rejections, the applicants for the '033 Patent, including Mr. Kjellberg, stated that through Unwired Planet's acquisition of Ellipsus Systems, Unwired Planet was "thoroughly familiar with the product disclosed in the [infiniteMAP white paper] and [is] more-than-qualified to comment on the extent of that reference's disclosure." Amendment dated July 18, 2006; *see also* Amendment dated October 10, 2006 ("Applicants respectfully maintain all of their previously submitted arguments regarding the prior art rejections"). Mr. Kjellberg and the other applicants traversed the examiner's assertion of inherency and claimed that, due to Unwired Planet's familiarity with the Ellipsus product, "the Examiner is not in a position to dispute Applicants' arguments regarding the Ellipsus reference, absent clear evidence which confirms the Examiner's assertion of inherency." Amendment dated July 18, 2006.

25. Contrary to Mr. Kjellberg's and the applicants' assertions, and unbeknownst to the examiner, a white paper describing infiniteMASS co-authored by Mr. Kjellberg and in the possession of Unwired Planet was material to the examination

1 of the application, as it disclosed a “plurality of domains,” for example in describing
2 infiniteMASS as being “positioned in the enterprise information technology (IT)
3 infrastructure between the content server and the wireless network, and links end users
4 with the content. The content can be delivered to the largest possible user population,
5 since infiniteMASS provides the bridge between the multitude of mobile devices and a
6 content source, such as an enterprise portal or e-commerce server. This is possible
7 since infiniteMASS supports both the content formatting and wireless communication
8 protocol functionality, providing a number of ‘distribution channels’ between a content
9 source and users.” Exhibit 1 at 2.

10 26. Further contrary to Mr. Kjellberg’s and the applicants’ assertions, and
11 unbeknownst to the examiner, a white paper describing EAA co-authored by Mr.
12 Kjellberg and in the possession of Unwired Planet was material to the examination of
13 the application, as it disclosed a “plurality of domains,” for example in describing
14 EAA as allowing “infiniteMASS [to] dispatch messages to the appropriate channel
15 (RMI, CORBA, DCOM or SOAP) based on the structure of the incoming request from
16 the mobile device. This request is in the form of a Unified Resource Locator (URL),
17 which will typically indicate channel, object, method and parameters.” Exhibit 2 at 4.

18 27. Further, on information and belief, user manuals, technical support
19 documents, and other documentation describing the Ellipsus Products existed and were
20 in the possession of Unwired Planet, and were material to the examination of the
21 application. For example, on information and belief, such documentation discloses
22 and/or renders obvious a “plurality of domains.”

23 28. None of the withheld Ellipsus documents are cumulative of the
24 infiniteMAP white paper. The infiniteMASS and EAA white papers disclose a
25 “plurality of domains,” a limitation that the examiner stated was only inherently
26 disclosed by the infiniteMAP white paper and that Mr. Kjellberg and the applicants
27 argued was missing from the infiniteMAP white paper. On information and belief,
28 other documents describing the Ellipsus Products, including user manuals and

1 technical support documents, were not cumulative of the infiniteMAP white paper and
2 disclosed explicitly a “plurality of domains.”

3 29. Mr. Kjellberg’s September 30, 2005 statement that he was “not aware of
4 any other information that may be material to the examination of this application” was
5 an affirmative misrepresentation of material fact as, on information and belief, Mr.
6 Kjellberg, the founder of Ellipsus and co-author of the infiniteMASS and EAA white
7 papers, was aware of the documents in Unwired Planet’s possession describing the
8 Ellipsus Products, including the white papers describing the infiniteMASS and the
9 EAA products and user manuals and technical support documents for all of the
10 Ellipsus Products.

11 30. On information and belief, Mr. Kjellberg withheld the Ellipsus Products
12 documents with the intent to deceive the USPTO in order to secure issuance of the
13 ’033 Patent. On information and belief, Mr. Kjellberg knew that had the examiner
14 been aware of the Ellipsus Products documents, including the infiniteMASS and the
15 EAA white papers and other supporting documents, the examiner would have rejected
16 the claims of the application for the ’033 Patent and would not have allowed those
17 claims to issue.

18 31. Because of the inequitable conduct committed by Mr. Kjellberg in
19 connection with the ’033 Patent, the ’033 Patent is unenforceable, and Unwired Planet
20 may not obtain any relief regarding it.

21 **U.S. Patent No. 7,233,790**

22 32. During prosecution of the ’790 Patent, individuals associated with
23 prosecution of the patent withheld material, non-cumulative prior art from the patent
24 examiner with intent to deceive the USPTO. This material prior art included Unwired
25 Planet’s own commercial activity, as well as that of its predecessor-in-interest, and
26 printed publications relating to that activity, as described below.

27 33. The ’790 Patent states on its face that it issued from U.S. Patent
28 Application No. 10/600,746, filed on June 19, 2003. The ’790 Patent also states that it

1 is related to Provisional Applications No. 60/393,024, 60/392,383, 60/393,041, and
2 60/392,999, all filed on June 28, 2002.

3 34. The '790 Patent on its face, and at all times during its prosecution, claims
4 "receiving . . . a plurality of different implementations of at least one of the items of
5 content, where each implementation of any given item of content corresponds to a
6 different set of device capabilities" This limitation was cited by the examiner in
7 the reasons for allowance as being missing from the prior art of record.

8 35. More than one year before this Provisional Application was filed,
9 Ellipsus, which was acquired by Unwired Planet before the '790 Patent's earliest
10 priority date, had offered for sale and put into public use the Ellipsus Products, each of
11 which involved and disclosed each element of at least one claim of the '790 Patent.

12 36. For example, the Ellipsis Products are described in the following
13 publications, each of which was published before June 28, 2001:

- 14 • White Paper – infiniteMASS, Ellipsus' Mobile Application Server Suite (*see*
15 Exhibit 1);
- 16 • White Paper – EAA, Ellipsus' EAA (*see* Exhibit 2); and
- 17 • Ellipsus System Unveils First 100%-Java Wireless Web Services Platform
18 (June 2001 press release) (*see* Exhibit 3).

19 On information and belief, user manuals, technical support documents and other
20 documents related to the infiniteMAP, the infiniteMASS, and the EAA systems.

21 37. Neither infiniteMASS nor EAA, nor any of the publications named above,
22 are disclosed anywhere on the face of the '790 Patent or in the patent's prosecution
23 history.

24 38. Each of the infiniteMASS and EAA systems is prior art to the '790 Patent
25 under 35 U.S.C. §§ 102(a) and 102(b). Each of the publications named above is prior
26 art to the '790 Patent under 35 U.S.C. §§ 102(a) and 102(b).

27 39. Each of the infiniteMASS and EAA systems is material prior art to the
28 '790 Patent and is not cumulative of any prior art of record. Each of the publications

1 named above is material prior art to the '790 Patent and is not cumulative of any prior
2 art of record.

3 40. On information and belief, the examiner of the '790 Patent was not aware
4 of infiniteMASS or EAA, or any of the publications named above relating thereto. On
5 information and belief, the examiner was not aware of the publications named above
6 relating to infiniteMAP (the "withheld infiniteMAP documents"). *See* Exhibit 4. Had
7 the examiner been aware of infiniteMASS or EAA or any of these publications,
8 including the withheld infiniteMAP documents, the examiner would have rejected the
9 claims of the '790 Patent and would not have allowed them to issue, because the
10 infiniteMASS and EAA systems and each of these publications disclosed or rendered
11 obvious each and every limitation of the claims of the '790 Patent.

12 41. For example, with respect to Claim 1 of the '790 Patent, infiniteMASS
13 and EAA performed methods of providing access to content for use in wireless
14 communication devices, including receiving and storing a plurality of different
15 implementations of at least one of the items of content, where each implementation of
16 any given item of content corresponds to a different set of device capabilities, and
17 maintaining a product catalog containing a description of the items of content with a
18 reference to each implementation of said item of content. Had the examiner been
19 aware of infiniteMASS, EAA, or any of the publications named above, the examiner
20 would have rejected Claim 1 under 35 U.S.C. §§ 102 and 103.

21 42. On information and belief, the withheld infiniteMAP documents disclose
22 the method of providing access to content for use in wireless communication devices,
23 including receiving and storing a plurality of different implementations of at least one
24 of the items of content, where each implementation of any given item of content
25 corresponds to a different set of device capabilities, and maintaining a product catalog
26 containing a description of the items of content with a reference to each
27 implementation of said item of content. Had the examiner been aware of the withheld
28 infiniteMAP documents, the examiner would have rejected Claim 1 under 35 U.S.C.

1 §§ 102 and 103.

2 43. On information and belief, individuals associated with prosecution of the
3 '790 Patent, including at least named inventor Rikard M. Kjellberg, withheld the
4 infiniteMASS and EAA prior art (including Ellipsus's offers for sale and public use of
5 these systems) from the examiner, with intent to deceive the USPTO. On information
6 and belief, Mr. Kjellberg withheld the withheld infiniteMAP documents from the
7 examiner with intent to deceive the USPTO.

8 44. Mr. Kjellberg was a co-founder of Ellipsus Systems and a co-author of the
9 infiniteMASS and EAA white papers.

10 45. Mr. Kjellberg therefore knew that the infiniteMASS and EAA systems,
11 and each of the publications named above, including the withheld infiniteMAP
12 documents, were prior art to, and disclosed the limitations of the claims of, the
13 application for the '790 Patent. Yet Mr. Kjellberg did not disclose the infiniteMASS
14 and EAA systems, or any of the publications named above, including the withheld
15 infiniteMAP documents, to the examiner of the '790 Patent.

16 46. During prosecution of the '033 Patent, with regards to a similar white
17 paper on Ellipsus's infiniteMAP product, Mr. Kjellberg and the other applicants of the
18 '033 Patent stated that as a result of Unwired Planet's acquisition of Ellipsus,
19 "[Unwired Planet is] thoroughly familiar with the product disclosed in the
20 [infiniteMAP white paper] and are more-than-qualified to comment on the extent of
21 that reference's disclosure." Amendment dated July 18, 2006. Mr. Kjellberg's claim
22 of thorough familiarity with infiniteMAP demonstrates his knowledge of the withheld
23 infiniteMAP documents.

24 47. On information and belief, Mr. Kjellberg withheld from the examiner of
25 the '790 Patent the infiniteMASS and EAA systems and each of the publications
26 named above, including the withheld infiniteMAP documents, with intent to deceive
27 the USPTO. On information and belief, Mr. Kjellberg knew that had the examiner
28 been aware of the withheld art, the examiner would have rejected the claims of the

1 application for the '790 Patent and would not have allowed those claims to issue.

2 48. Thus, by withholding the infiniteMAP and EAA systems, and each of the
3 publications named above, from the examiner, Mr. Kjellberg deceived the examiner
4 and the USPTO in order to obtain issuance of the '790 Patent.

5 49. Because of the inequitable conduct committed by Mr. Kjellberg in
6 connection with the '790 Patent, the '790 Patent is unenforceable, and Unwired Planet
7 may not obtain any relief regarding it.

8 **U.S. Patent No. 7,020,685**

9 50. During prosecution of the '685 Patent, Unwired Planet and individuals
10 associated with prosecution of the patent withheld material, non-cumulative prior art
11 from the patent examiner with intent to deceive the USPTO. This material prior art
12 included Unwired Planet's own commercial activity, printed publications relating to
13 that activity, and at least one prior art patent reference, as described below.

14 51. The '685 Patent states on its face that it issued from U.S. Patent
15 Application No. 09/640,902, filed on August 16, 2000. The '685 Patent also states that
16 it is related to Provisional Application No. 60/158,694, filed on October 8, 1999.

17 *UP.Link and PocketNet*

18 52. More than one year before the Provisional Application to the '685 Patent
19 was filed, Unwired Planet had offered for sale and put into public use the UP.Link and
20 PocketNet systems, each of which involved and disclosed each element of at least one
21 claim of the '685 Patent.

22 53. The UP.Link and/or PocketNet systems are described in the following
23 exemplary publications, each of which was published before October 8, 1998:

- 24 • UP.Link Developer's Guide, Version 1.0 (*see* Exhibit 5);
- 25 • Using the UP.Browser, Version 1.01 (*see* Exhibit 6);
- 26 • HDTP Specification, Version 1.1 (*see* Exhibit 7);
- 27 • Unwired Planet Announces UP.Link Platform 2.0 (press release dated July 8,
28 1997) (*see* Exhibit 8);

- 1 • Unwired Planet Brings the Web to Cellular Telephones and Pagers (press
2 release dated July 15, 1996) (*see* Exhibit 9);
- 3 • Using UP.Mail (July 1997) (*see* Exhibit 10); and
- 4 • Developing Applications for the PocketNet Phone (1996 White Paper) (*see*
5 Exhibit 11).

6 Collectively, the UP.Link and PocketNet systems, including any publications
7 describing those systems, will be referred to herein as the “UP.Link and PocketNet
8 Prior Art.”

9 54. None of the UP.Link and PocketNet Prior Art is disclosed anywhere on
10 the face of the '685 Patent or in its prosecution history.

11 55. The UP.Link and PocketNet Prior Art is prior art to the '685 Patent under
12 35 U.S.C. §§ 102(a) and 102(b). The UP.Link and/or PocketNet systems, and/or each
13 of the publications named above, is prior art to the '685 Patent under 35 U.S.C. §§
14 102(a) and 102(b).

15 56. Each of the UP.Link and PocketNet Prior Art is material prior art to the
16 '685 Patent and is not cumulative of any prior art of record. Each of the publications
17 named above is material prior art to the '685 Patent and is not cumulative of any prior
18 art of record.

19 57. On information and belief, the examiner of the '685 Patent was not aware
20 of the UP.Link and PocketNet Prior Art. Had the examiner been aware of the UP.Link
21 and PocketNet Prior Art, the examiner would have rejected the claims of the '685
22 Patent and would not have allowed them to issue, because the UP.Link and PocketNet
23 Prior Art disclosed or rendered obvious each and every limitation of the claims of the
24 '685 Patent.

25 58. For example, with respect to Claim 1 of the '685 Patent, UP.Link and
26 PocketNet performed methods of providing content from a network to a wireless
27 device, including retrieving content from a resource on a network according to a
28 hypermedia protocol with which the wireless device was not compliant, and converting

1 the content to a message compliant with a message requirement of the wireless device.
2 As explained by the UP.Link Developer's Guide, the UP.Link system retrieved
3 network content using the HTTP protocol, with which UP.Phone wireless devices were
4 not compliant. Then the UP.Link system converted the retrieved content to a message
5 compliant with UP.Phone wireless devices. *See, e.g.*, Exhibit 5 (UP.Link Developer's
6 Guide, v. 1.0) at v. *See also* Exhibit 11 (Developing Applications for the PocketNet
7 Phone, 1996 White Paper) at 3 (showing "PocketNet Information Flow" in which an
8 "UPLink [sic] Gateway" retrieves network content using the HTTP protocol and then
9 converts the retrieved content to a "HDML Command" message compliant with
10 "UPLink-enabled Phone[s]").

11 59. Had the examiner been aware of the UP.Link and PocketNet Prior Art, the
12 examiner would have rejected Claim 1 under 35 U.S.C. §§ 102 and 103, because the
13 UP.Link and PocketNet Prior Art disclosed or rendered obvious each and every
14 limitation of Claim 1.

15 60. On information and belief, individuals associated with prosecution of the
16 '685 Patent, including at least named inventor David A. Chen and prosecution counsel
17 Jordan Becker, withheld the UP.Link and PocketNet Prior Art (including Unwired
18 Planet's offers for sale and public use of these systems) from the examiner of the
19 application for the '685 Patent, with intent to deceive the USPTO.

20 61. On information and belief, Mr. Chen was employed by Unwired Planet at
21 least as early as April 1998, more than one year before the filing of the Provisional
22 Application to which the '685 Patent purports to claim priority. On information and
23 belief, Mr. Chen was a Senior Product Manager for Unwired Planet's Mobile Browser
24 business, and was involved in Unwired Planet's prior-art commercial activity including
25 the sale, offer for sale, or public use of the UP.Link or PocketNet Systems or related
26 systems. For example, a page on the website LinkedIn regarding Mr. Chen states that
27 he "[d]rove mobile browser product through company's [Unwired Planet's] first
28 volume rollout across multiple handset OEMs and US and Japanese wireless

1 operators” and “[l]ed production of industry’s first WAP-standard mobile browser for
2 worldwide use.” *See* Exhibit 12, <http://www.linkedin.com/profile/view?id=2045186>
3 (last visited Nov. 27, 2012).

4 62. On information and belief, Mr. Chen knew about the UP.Link and
5 PocketNet Prior Art because of his work on Unwired Planet’s Mobile Browser
6 business, and knew that they were prior art to, and disclosed the limitations of the
7 claims of, the application for the ’685 Patent. Yet Mr. Chen did not disclose the
8 UP.Link and PocketNet Prior Art to the examiner of the ’685 Patent.

9 63. Mr. Becker prosecuted multiple patent applications for Unwired Planet,
10 including several other applications that were pending before or during the pendency
11 of the ’685 Patent. Those other applications included applications that related to
12 Unwired Planet’s Mobile Browser business, including to the UP.Link and PocketNet
13 systems. On information and belief, Mr. Becker knew about the UP.Link and
14 PocketNet Prior Art at least via his work on patent applications filed by Unwired
15 Planet, and knew that they were prior art to, and disclosed the limitations of the claims
16 of, the application for the ’685 Patent. Yet Mr. Becker did not disclose the UP.Link
17 and PocketNet Prior Art to the examiner of the ’685 Patent.

18 64. For example, Mr. Becker was involved in prosecution of U.S. Patent No.
19 6,742,127, entitled “Method and Apparatus for Maintaining Security in a Push
20 System” (“the ’127 Patent”). The ’127 Patent issued to Unwired Planet’s predecessor
21 Openwave Systems, Inc. on May 25, 2004, while the ’685 Patent was still pending.
22 The ’127 Patent discusses an “UP.Link Gateway” that converts between hypermedia
23 formats. *See, e.g.*, ’127 patent, Fig. 1, col. 4:4-13. On information and belief, Mr.
24 Becker was aware of the “UP.Link Gateway” disclosed in the ’127 Patent (which he
25 was involved in prosecuting), was aware that it related to Unwired Planet’s UP.Link
26 system, and was aware that the UP.Link system was on sale and in public use before
27 October 8, 1998.

28 65. For further example, Mr. Becker was involved in the prosecution of U.S.

1 Patent No. 6,665,711, entitled “Method and Apparatus for Integrating Narrowband and
2 Wideband Data Transports” (“the ’711 Patent”). The ’711 Patent issued to Unwired
3 Planet’s predecessor Openwave Systems, Inc. on December 16, 2003, while the ’685
4 Patent was still pending. The ’711 Patent discusses the UP.Link Gateway and also
5 discusses a wireless device obtaining access to information from
6 “www.att.com/PocketNet.” *See, e.g.*, ’711 Patent, Fig. 1, col. 9:5-6. On information
7 and belief, Mr. Becker was aware of the PocketNet discussion in the ’711 Patent
8 (which he was involved in prosecuting), was aware that it related to Unwired Planet’s
9 commercial activity regarding the PocketNet system, and was aware that the
10 PocketNet system was on sale and in public use before October 8, 1998.

11 66. On information and belief, both Mr. Becker and Mr. Chen withheld
12 from the examiner of the ’685 Patent the UP.Link and PocketNet systems and each of
13 the publications named above with intent to deceive the USPTO. On information and
14 belief, Mr. Becker and Mr. Chen each knew that had the examiner been aware of the
15 UP.Link and PocketNet Prior Art, the examiner would have rejected the claims of the
16 application for the ’685 Patent and would not have allowed those claims to issue.

17 67. For example, the examiner of the ’685 Patent repeatedly rejected all
18 claims over U.S. Patent No. 6,473,609 (“the ’609 Patent”), explaining that the ’609
19 Patent discloses or renders obvious (in combination with other references) all
20 limitations of the claims of the application for the ’685 Patent. *See* U.S Patent
21 Application 09/640,902, Office Actions dated November 14, 2003, and April 26, 2004.
22 In response, Unwired Planet (in filings by Mr. Becker) represented to the examiner that
23 the ’609 Patent was not prior art to the application for the ’685 Patent because the
24 subject matter was owned by or subject to an obligation of assignment to the same
25 person (Unwired Planet’s predecessor Phone.com) at the time of the alleged invention.
26 *See id.*, Amendments dated February 17, 2004, and June 17, 2004. The examiner then
27 withdrew the rejections for anticipation and obviousness, and instead issued a rejection
28 for double patenting over the ’609 Patent. *See id.*, Office Action dated July 29, 2004.

1 Unwired Planet was able to overcome this double-patenting rejection by filing a
2 terminal disclaimer, resulting in a notice of allowance. *See id.*, Amendment and
3 Terminal Disclaimer dated August 10, 2004 and Notice of Allowance dated October 7,
4 2004.

5 68. Had the examiner been informed about the UP.Link and PocketNet Prior
6 Art, the examiner would have rejected the claims of the '685 Patent over that art as
7 well, as it disclosed the very same limitations that the examiner found disclosed by the
8 '609 Patent. And Unwired Planet would not have been able to rely on the common-
9 ownership provision of the Patent Act to overcome such a rejection. For example, the
10 examiner's November 14, 2003 rejection explained that the '609 Patent discloses a
11 "method of providing content from a network to a wireless device" including the steps
12 of "receiving the content from a resource on the network according to a hypermedia
13 protocol, wherein the wireless device is not compliant with the hypermedia protocol,"
14 and "converting the content to a message compliant with a message requirement of the
15 wireless device." *Id.* at 2. As explained above, the UP.Link and PocketNet systems
16 disclosed these very same limitations. For example, the UP.Link Developer's Guide
17 explains that the UP.Link system retrieved network content via the HTTP protocol and
18 converted the content to a message compliant with message requirements of UP.Link
19 Phone wireless devices.

20 69. The common-ownership provision does not exempt art that qualifies
21 under section 102(b), including prior public use, offers for sale, and printed
22 publications such as the UP.Link and PocketNet Prior Art. *See* 35 U.S.C. § 103(c).

23 70. Thus, by withholding the UP.Link and PocketNet Prior Art from the
24 examiner, Mr. Becker and Mr. Chen deceived the examiner into allowing claims that
25 should not have been allowed, and deceived the USPTO into issuing the '685 Patent.
26 On information and belief, Mr. Becker and Mr. Chen withheld the UP.Link and
27 PocketNet Prior Art with intent to so deceive the examiner and the USPTO.

28 ///

U.S. Patent 6,094,587 (“Armanto”)

71. United States Patent No. 6,094,587 (“Armanto”) is prior art to the ’685 Patent under 35 U.S.C. § 102(e). *See* Exhibit 13.

72. Armanto discloses a method of sending a ringtone to a wireless device by converting the ringtone into an SMS message and sending the SMS message to the wireless device.

73. Armanto is not cited on the face of the ’685 Patent or in the prosecution history of the ’685 Patent.

74. Armanto is material to the claims of the ’685 Patent, and is not cumulative of the art of record.

75. On information and belief, the examiner of the ’685 Patent was not aware of Armanto. Had the examiner been aware of Armanto, the examiner would have rejected the claims of the ’685 Patent and would not have allowed them to issue, because Armanto disclosed or rendered obvious each and every limitation of the claims of the ’685 Patent.

76. For example, Armanto discloses the following element of Claim 1 of the ’685 Patent, which Unwired Planet contended was a distinction over the prior art: converting the content to a message compliant with a message requirement of the wireless device, including generating a message including the content. *See, e.g.,* Exhibit 13 (Armanto), Abstract (disclosing a method in which a “ringing tone is transformed into characters containing specifications of notes and the characters are sent to the telephone, e.g., in a short message”). Had the examiner been aware of Armanto, the examiner would have rejected Claim 1 under 35 U.S.C. §§ 102 and 103.

77. On information and belief, individuals associated with the prosecution of the ’685 Patent, including at least named inventor David A. Chen and prosecution counsel Jordan Becker, withheld Armanto from the examiner of the application for the ’685 Patent with intent to deceive the USPTO.

78. Mr. Becker was aware of Armanto by the time that that Mr. Becker was

1 prosecuting the application that issued as the '685 Patent. For example, Mr. Becker
2 submitted Armanto to the USPTO as part of an Information Disclosure Statement filed
3 by Mr. Becker on November 4, 1995 in the prosecution of U.S. Patent App. No.
4 09/999,656.

5 79. Despite having been aware of Armanto and having submitted it to the
6 USPTO in connection with a different patent application, Mr. Becker did not submit
7 Armanto to the USPTO in connection with the prosecution of the '685 Patent.

8 80. On information and belief, Mr. Becker was aware that Armanto was
9 material to the application for the '685 Patent, and withheld Armanto from the
10 examiner with intent to deceive the examiner and the USPTO into allowing the '685
11 Patent to issue when it should not have been allowed.

12 81. On information and belief, Mr. Chen was also aware of Armanto, for
13 example from Mr. Becker's submission of Armanto to the USPTO in connection with
14 the prosecution of U.S. Patent App. No. 09/999,656, on which Mr. Chen was named as
15 an inventor. On information and belief, Mr. Chen was aware that Armanto was
16 material to the application for the '685 Patent, and withheld Armanto from the
17 examiner with intent to deceive the examiner and the USPTO into allowing the '685
18 Patent to issue when it should not have been allowed.

19 82. Because of the inequitable conduct committed by Mr. Chen and Mr.
20 Becker in connection with the '685 Patent, the '685 Patent is unenforceable, and
21 Unwired Planet may not obtain any relief regarding it.

22 **U.S. Patent No. 6,647,260**

23 83. During prosecution of the '260 Patent, Unwired Planet and individuals
24 associated with prosecution of the patent withheld material, non-cumulative prior art
25 from the patent examiner with intent to deceive the USPTO. This material prior art
26 included Unwired Planet's own commercial activity, printed publications relating to
27 that activity, and at least one prior art patent reference, as described below.

28 84. The '260 Patent states on its face that it issued from U.S. Patent

1 Application No. 09/289,559, filed on April 9, 1999.

2 *UP.Link and PocketNet*

3 85. More than one year before this application was filed, Unwired Planet had
4 offered for sale and put into public use the UP.Link and PocketNet systems, each of
5 which involved and disclosed each element of at least one claim of the '260 Patent.

6 86. For example, the UP.Link and/or PocketNet systems are described in the
7 following publications, each of which was published before April 9, 1998:

- 8 • UP.Link Developer's Guide, Version 1.0 (*see* Exhibit 5);
- 9 • Using the UP.Browser, Version 1.01 (*see* Exhibit 6);
- 10 • HDTP Specification, Version 1.1 (*see* Exhibit 7);
- 11 • Unwired Planet Announces UP.Link Platform 2.0 (press release dated July 8,
12 1997) (*see* Exhibit 8);
- 13 • Unwired Planet Brings the Web to Cellular Telephones and Pagers (press
14 release dated July 15, 1996) (*see* Exhibit 9);
- 15 • Using UP.Mail (July 1997) (*see* Exhibit 10); and
- 16 • Developing Applications for the PocketNet Phone (1996 White Paper) (*see*
17 Exhibit 11).

18 Collectively, the UP.Link and PocketNet systems, including any publications
19 describing those systems, will be referred to herein as the "UP.Link and PocketNet
20 Prior Art."

21 87. None of the UP.Link and PocketNet Prior Art is disclosed anywhere on
22 the face of the '260 Patent or in its prosecution history. Neither the UP.Link or
23 PocketNet systems, nor any of the publications named above, is disclosed anywhere on
24 the face of the '260 Patent or in its prosecution history.

25 88. Each of the UP.Link and PocketNet Prior Art is prior art to the '260
26 Patent under 35 U.S.C. §§ 102(a) and 102(b). Each of the publications named above is
27 prior art to the '260 Patent under 35 U.S.C. §§ 102(a) and 102(b).

28 89. Each of the UP.Link and PocketNet Prior Art is material prior art to the

1 '260 Patent and is not cumulative of any prior art of record. Each of the UP.Link and
2 PocketNet systems, and each of the publications named above, is material prior art to
3 the '260 Patent and is not cumulative of any prior art of record.

4 90. On information and belief, the examiner of the '260 Patent was not aware
5 of the UP.Link or PocketNet Prior Art. Had the examiner been aware of the UP.Link
6 or PocketNet Prior Art, the examiner would have rejected the claims of the '260 Patent
7 and would not have allowed them to issue, because the UP.Link and PocketNet Prior
8 Art disclosed or rendered obvious each and every limitation of the claims of the '260
9 Patent.

10 91. For example, with respect to Claim 1 of the '260 Patent, UP.Link and
11 PocketNet performed methods of provisioning a two-way mobile communications
12 device having a display and a user interface, with the mobile communications device
13 receiving user information, displaying a list of selectable identifiers on the display,
14 receiving a user's selection of an identifier, generating a provisioning request
15 comprising the user information and the selection, establishing a communication link
16 and authenticating with a remote server, sending the provisioning request to the
17 provisioning server, receiving a reply, and provisioning the two-way communications
18 device with a feature or service based on the reply. Had the examiner been aware of
19 the UP.Link and PocketNet Prior Art, the examiner would have rejected Claim 1 under
20 35 U.S.C. §§ 102 and 103.

21 92. On information and belief, individuals associated with prosecution of the
22 '260 Patent, including at least named inventors Peter F. King, Bruce V. Schwartz, and
23 Bruce K. Martin, Jr., withheld the UP.Link and PocketNet Prior Art (including
24 Unwired Planet's offers for sale and public use of these systems) from the examiner of
25 the application for the '260 Patent, with intent to deceive the USPTO.

26 93. On information and belief, Mr. King was employed by Openwave
27 Systems and its precursors Phone.com and Unwired Planet at least as early as 1995,
28 more than one year before the filing of the Application which led to the '260 Patent.

1 On information and belief, Mr. King was Director of Technology of Openwave, and
2 was involved in Unwired Planet's prior-art commercial activity including the sale,
3 offer for sale, or public use of the UP.Link or PocketNet Systems or related systems.
4 On information and belief, Mr. King knew about the UP.Link and PocketNet Prior Art
5 because of his work on Openwave's Mobile Browser business, including UP.Link
6 specifically, and because he was in charge of managing Unwired Planet's patent
7 process in 1997 and 1998, and knew that they were prior art to, and disclosed the
8 limitations of the claims of, the application for the '260 Patent. On information and
9 belief, Mr. King was particularly aware of the HDTP Specification 1.0 (*see* Exhibit 7)
10 because he authored it. Yet Mr. King did not disclose the UP.Link and PocketNet
11 Prior Art to the examiner of the '260 Patent.

12 94. On information and belief, Mr. Schwartz was employed by Openwave
13 Systems and its precursors Phone.com and Unwired Planet at least as early as
14 November 1994, more than one year before the filing of the Application which led to
15 the '260 Patent. On information and belief, Mr. Schwartz was Co-Founder of
16 Phone.com and a Member of Technical Staff at Phone.com and Openwave, and was
17 involved in Unwired Planet's prior-art commercial activity including the sale, offer for
18 sale, or public use of the UP.Link or PocketNet Systems or related systems. On
19 information and belief, Mr. Schwartz knew about the UP.Link and PocketNet Prior Art
20 because of his work on Openwave's Mobile Browser business, and knew that they
21 were prior art to, and disclosed the limitations of the claims of, the application for the
22 '260 Patent. Yet Mr. Schwartz did not disclose the UP.Link and PocketNet Prior Art
23 to the examiner of the '260 Patent.

24 95. On information and belief, Mr. Martin was employed by Openwave
25 Systems and its precursors Phone.com and Unwired Planet at least as early as 1995,
26 more than one year before the filing of the Application which led to the '260 Patent.
27 On information and belief, Mr. Martin was Chief Technology Officer of Openwave,
28 and was involved in Unwired Planet's prior-art commercial activity including the sale,

1 offer for sale, or public use of the UP.Link or PocketNet Systems or related systems.
2 On information and belief, Mr. Martin knew about the UP.Link and PocketNet Prior
3 Art because of his work on Openwave's Mobile Browser business, and knew that they
4 were prior art to, and disclosed the limitations of the claims of, the application for the
5 '260 Patent. Yet Mr. Martin did not disclose the UP.Link and PocketNet Prior Art to
6 the examiner of the '260 Patent.

7 96. On information and belief, Messrs. King, Schwartz, and Martin
8 withheld from the examiner of the '260 Patent the UP.Link and PocketNet Prior Art
9 with intent to deceive the USPTO. On information and belief, Messrs. King,
10 Schwartz, and Martin each knew that had the examiner been aware of the UP.Link and
11 PocketNet Prior Art, the examiner would have rejected the claims of the application
12 for the '260 Patent and would not have allowed those claims to issue.

13 97. For example, the examiner of the '260 Patent initially rejected all claims
14 over U.S. Patent No. 6,031,830 ("the '830 Patent"), explaining that the '830 Patent
15 discloses or renders obvious (in combination with other references) all limitations of
16 the claims of the application for the '260 Patent. *See* U.S Patent Application
17 09/289,559, Office Action dated July 31, 2001. In response, Unwired Planet
18 represented to the examiner that the limitation of the '260 Patent whereby the user
19 input is received by the device was not present in the '830 Patent. Similarly, the
20 examiner of the '260 Patent then rejected all claims over U.S. Patent No. 5,812,953
21 ("the '953 Patent"), explaining that the '953 Patent discloses or renders obvious (in
22 combination with other references) all limitations of the claims of the application for
23 the '260 Patent. *See* U.S Patent Application 09/289,559, Office Action dated January
24 16, 2002. In response, Unwired Planet represented to the examiner that the limitation
25 of the '260 Patent whereby the selections available to the user are displayed and the
26 user selects one of the displayed selections was not present in the '953 Patent.

27 98. Based on Unwired Planet's representations as to the prior art's missing
28 limitations, the examiner allowed the '260 Patent to issue. Had the examiner been

1 informed about the UP.Link and PocketNet Prior Art, the examiner would have
2 rejected the claims of the '260 Patent over that prior art, as it disclosed the very same
3 limitations that Unwired Planet argued were not present in the '830 or '953 patents.
4 The UP.Link and PocketNet phones, for example, clearly disclosed receiving user
5 input by the device, which Unwired Planet argued was missing from the '830 Patent,
6 since UP.Link and PocketNet phones displayed users a list of choices which could be
7 selected. *See* Exhibit 5 (UP.Link Developer's Guide, v. 1.0) at 25. Similarly, UP.Link
8 and PocketNet phones disclosed displaying selections and receiving a selection of
9 those displayed, which Unwired Planet argued was missing from the '953 Patents,
10 when displaying lists of choices to the user for selection. *Id.*

11 99. Thus, by withholding the UP.Link and PocketNet Prior Art from the
12 examiner, Messrs. King, Schwartz, and Martin deceived the examiner into allowing
13 claims that should not have been allowed, and deceived the USPTO into issuing the
14 '260 Patent. On information and belief, Messrs. King, Schwartz, and Martin withheld
15 the UP.Link and PocketNet Prior Art with intent to so deceive the examiner and the
16 USPTO.

17 100. Because of the inequitable conduct committed by Messrs. King,
18 Schwartz, and Martin in connection with the '260 Patent, the '260 Patent is
19 unenforceable, and Unwired Planet may not obtain any relief regarding it.

20 **RIGHT TO ALLEGE FURTHER DEFENSES**

21 **AS SUPPORTED BY THE EVIDENCE**

22 101. Apple reserves the right to assert additional defenses that become known
23 through the course of discovery and investigation of this case, including but not limited
24 to additional defenses relating to inequitable conduct.

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COUNTERCLAIM

Counterclaimant Apple, by and through its attorneys, asserts the following Counterclaim against Counterdefendant Unwired Planet.

1. Apple re-alleges and incorporates by reference each and every allegation contained in paragraphs 1-100 inclusive of its Affirmative and Other Defenses, as if fully set forth herein.

2. Apple is a corporation duly organized and existing under the laws of California and has its principal place of business at 1 Infinite Loop, Cupertino, California 95014.

3. On information and belief, Unwired Planet is a Nevada entity having its principal place of business at 226 California Avenue, Reno, Nevada 89509.

4. In its Counterclaims, Apple seeks declarations of invalidity and non-infringement of the Asserted Patents. This Court has jurisdiction pursuant to the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, under federal question jurisdiction pursuant to 28 U.S.C. § 1331, and pursuant to the Patent Laws of the United States, 35 U.S.C. § 1 *et seq.*, and pursuant to 28 U.S.C. § 1332.

5. This Court has personal jurisdiction over Unwired Planet at least because it has submitted to the jurisdiction of this Court.

6. Venue is proper under 28 U.S.C. §§ 1391 and 1400(b).

7. On or about September 19, 2012, Unwired Planet filed its Complaint for Patent Infringement, alleging that Unwired Planet is the owner by assignment of the entire right, title and interest in and to the Asserted Patents.

8. In its Complaint, Unwired Planet named Apple as Defendant and asserted claims of patent infringement against Defendants under 35 U.S.C. §§ 271, 271(b) and 271(c). As a result of at least the allegations contained in Unwired Planet's Complaint and Apple's denial of such allegations, an actual and justiciable controversy exists.

9. The Asserted Patents are invalid for failure to meet the conditions of patentability and/or patent eligibility specified in Title 35 of the United States Code,

1 including, without limitation, sections 101, 102, 103, and 112, as set forth in paragraph
2 1 of Apple's Affirmative and Other Defenses.

3 10. Apple has not infringed and is not infringing the Asserted Patents,
4 willfully or otherwise, directly, contributorily or by inducement, either literally or by
5 application of the doctrine of equivalents.

6 11. Unwired Planet's claims against Apple under the '033, '790, '685, and
7 '260 Patents are barred because these patents are unenforceable due to inequitable
8 conduct, as set forth herein:

9 **U.S. Patent No. 7,299,033**

10 12. During prosecution of the '033 Patent, individuals associated with the
11 prosecution of the '033 Patent withheld material, non-cumulative prior art from the
12 patent examiner with intent to deceive the United States Patent and Trademark Office
13 ("USPTO"), and furthermore made affirmative misrepresentations of material facts
14 with the intent to deceive the USPTO. The withheld material, non-cumulative prior
15 art included Unwired Planet's own commercial activity, as well as that of its
16 predecessor-in-interest, and printed publications relating to that activity, as described
17 below.

18 13. The '033 Patent states on its face that it issued from U.S. Patent
19 Application No. 10/601,022, filed on June 19, 2003. The '033 Patent also states that it
20 is related to Provisional Application Nos. 60/393,024, 60/392,383, 60/393,041, and
21 60/392,999, all filed on June 28, 2002.

22 14. The '033 Patent on its face, and at all times during its prosecution, claims
23 a "plurality of domains" where "each of the domains [are] assigned thereto to a
24 particular set of digital products designed for use in wireless communication devices
25 that are accessible to the wireless services subscribers in that domain."

26 15. On or around May 29, 2002, Unwired Planet's predecessor Openwave
27 Systems, Inc. acquired a company called Ellipsus Systems, Inc. ("Ellipsus").

28 16. On information and belief, Ellipsus was founded originally by Rikard M.

1 Kjellberg, the first named inventor of the '033 Patent.

2 17. On information and belief, more than one year before June 28, 2002,
3 Ellipsus released three products related to mobile applications: infiniteMAP,
4 infiniteMASS, and Enterprise Application Adapters ("EAA") (combined, the "Ellipsus
5 Products").

6 18. On information and belief, on or around February 12, 2001, Ellipsus
7 published white papers describing each of the Ellipsus Products. On information and
8 belief, more than one year before June 28, 2002, Ellipsus published user manuals,
9 technical support documents, and other documents describing the Ellipsus Products.

10 19. The only Ellipsus-published document before the examiner of the '033
11 Patent was a 10-page white paper describing the infiniteMAP product ("infiniteMAP
12 white paper"). Exhibit 4. White papers describing infiniteMASS and EAA (Exhibits 1
13 and 2, respectively), on which Mr. Kjellberg was a co-author, were never identified or
14 provided to the examiner. Nor were any other documents describing the Ellipsus
15 Products, including user manuals or technical support documents, identified or
16 provided to the examiner.

17 20. On June 28, 2005, the examiner of the '033 Patent rejected the application
18 as being anticipated by the infiniteMAP white paper. The infiniteMAP white paper
19 had not been disclosed by Unwired Planet to the examiner. Instead, the examiner had
20 independently located the prior art reference in a November 22, 2004 Information
21 Disclosure Statement filed by Unwired Planet in a co-pending application that was
22 later issued as the '790 Patent. The co-pending application was not cross-referenced in
23 the '033 Patent application.

24 21. The examiner explained in his rejection that the infiniteMAP white paper
25 disclosed a "plurality of domains," because "it is inherent that there would be multiple
26 domains based on different devices capabilities and user profiles." Office Action dated
27 June 28, 2005.

28 22. The examiner further stated that "[i]n view of the inability of the

1 Examiner to obtain any additional Ellipsus information, as the company has been
2 acquired by the current assignee, Openwave Systems Inc., the Examiner is requesting
3 any additional information that Applicants may have access to that would be material
4 to the examination of the application.” *Id.*

5 23. On September 30, 2005, in response to the examiner’s request for
6 additional information, the applicants for the ’033 Patent, including Mr. Kjellberg,
7 stated that they were “not aware of any other information that may be material to the
8 examination of this application, other than the materials which have already been cited
9 and the materials which are being cited concurrently with the filing of this
10 amendment.” Amendment dated September 30, 2005.

11 24. On information and belief, Mr. Kjellberg, the founder of Ellipsus and first
12 named inventor on the ’033 Patent, was aware that other documents regarding the
13 Ellipsus Products existed, including white papers describing infiniteMASS and EAA
14 (Exhibits 1 and 2, respectively), of which Mr. Kjellberg was a co-author, and further
15 including user manuals, technical support documents, and other documents describing
16 the Ellipsus Products in Unwired Planet’s possession. On information and belief, Mr.
17 Kjellberg further knew that the withheld art plainly disclosed a “plurality of domains.”
18 Mr. Kjellberg’s statement in the September 30, 2005 Amendment therefore was an
19 affirmative misrepresentation of material fact made with intent to deceive the USPTO.

20 25. The examiner issued two more rejections of the application as being
21 anticipated by the infiniteMAP white paper, on December 20, 2005, and May 5, 2006,
22 for the reason that the infiniteMAP white paper inherently discloses a “plurality of
23 domains.”

24 26. In traversing both rejections, the applicants for the ’033 Patent, including
25 Mr. Kjellberg, stated that through Unwired Planet’s acquisition of Ellipsus Systems,
26 Unwired Planet was “thoroughly familiar with the product disclosed in the
27 [infiniteMAP white paper] and [is] more-than-qualified to comment on the extent of
28 that reference’s disclosure.” Amendment dated July 18, 2006; *see also* Amendment

1 dated October 10, 2006 (“Applicants respectfully maintain all of their previously
2 submitted arguments regarding the prior art rejections”). Mr. Kjellberg and the other
3 applicants traversed the examiner’s assertion of inherency and claimed that, due to
4 Unwired Planet’s familiarity with the Ellipsus product, “the Examiner is not in a
5 position to dispute Applicants’ arguments regarding the Ellipsus reference, absent clear
6 evidence which confirms the Examiner’s assertion of inherency.” Amendment dated
7 July 18, 2006.

8 27. Contrary to Mr. Kjellberg’s and the applicants’ assertions, and
9 unbeknownst to the examiner, a white paper describing infiniteMASS co-authored by
10 Mr. Kjellberg and in the possession of Unwired Planet was material to the examination
11 of the application, as it disclosed a “plurality of domains,” for example in describing
12 infiniteMASS as being “positioned in the enterprise information technology (IT)
13 infrastructure between the content server and the wireless network, and links end users
14 with the content. The content can be delivered to the largest possible user population,
15 since infiniteMASS provides the bridge between the multitude of mobile devices and a
16 content source, such as an enterprise portal or e-commerce server. This is possible
17 since infiniteMASS supports both the content formatting and wireless communication
18 protocol functionality, providing a number of ‘distribution channels’ between a content
19 source and users.” Exhibit 1 at 2.

20 28. Further contrary to Mr. Kjellberg’s and the applicants’ assertions, and
21 unbeknownst to the examiner, a white paper describing EAA co-authored by Mr.
22 Kjellberg and in the possession of Unwired Planet was material to the examination of
23 the application, as it disclosed a “plurality of domains,” for example in describing
24 EAA as allowing “infiniteMASS [to] dispatch messages to the appropriate channel
25 (RMI, CORBA, DCOM or SOAP) based on the structure of the incoming request from
26 the mobile device. This request is in the form of a Unified Resource Locator (URL),
27 which will typically indicate channel, object, method and parameters.” Exhibit 2 at 4.

28 29. Further, on information and belief, user manuals, technical support

1 documents, and other documentation describing the Ellipsus Products existed and were
2 in the possession of Unwired Planet, and were material to the examination of the
3 application. For example, on information and belief, such documentation discloses
4 and/or renders obvious a “plurality of domains.”

5 30. None of the withheld Ellipsus documents are cumulative of the
6 infiniteMAP white paper. The infiniteMASS and EAA white papers disclose a
7 “plurality of domains,” a limitation that the examiner stated was only inherently
8 disclosed by the infiniteMAP white paper and that Mr. Kjellberg and the applicants
9 argued was missing from the infiniteMAP white paper. On information and belief,
10 other documents describing the Ellipsus Products, including user manuals and
11 technical support documents, were not cumulative of the infiniteMAP white paper and
12 disclosed explicitly a “plurality of domains.”

13 31. Mr. Kjellberg’s September 30, 2005 statement that he was “not aware of
14 any other information that may be material to the examination of this application” was
15 an affirmative misrepresentation of material fact as, on information and belief, Mr.
16 Kjellberg, the founder of Ellipsus and co-author of the infiniteMASS and EAA white
17 papers, was aware of the documents in Unwired Planet’s possession describing the
18 Ellipsus Products, including the white papers describing the infiniteMASS and the
19 EAA products and user manuals and technical support documents for all of the
20 Ellipsus Products.

21 32. On information and belief, Mr. Kjellberg withheld the Ellipsus Products
22 documents with the intent to deceive the USPTO in order to secure issuance of the
23 ’033 Patent. On information and belief, Mr. Kjellberg knew that had the examiner
24 been aware of the Ellipsus Products documents, including the infiniteMASS and the
25 EAA white papers and other supporting documents, the examiner would have rejected
26 the claims of the application for the ’033 Patent and would not have allowed those
27 claims to issue.

28 33. Because of the inequitable conduct committed by Mr. Kjellberg in

1 connection with the '033 Patent, the '033 Patent is unenforceable, and Unwired Planet
2 may not obtain any relief regarding it.

3 **U.S. Patent No. 7,233,790**

4 34. During prosecution of the '790 Patent, individuals associated with
5 prosecution of the patent withheld material, non-cumulative prior art from the patent
6 examiner with intent to deceive the USPTO. This material prior art included Unwired
7 Planet's own commercial activity, as well as that of its predecessor-in-interest, and
8 printed publications relating to that activity, as described below.

9 35. The '790 Patent states on its face that it issued from U.S. Patent
10 Application No. 10/600,746, filed on June 19, 2003. The '790 Patent also states that it
11 is related to Provisional Applications No. 60/393,024, 60/392,383, 60/393,041, and
12 60/392,999, all filed on June 28, 2002.

13 36. The '790 Patent on its face, and at all times during its prosecution, claims
14 "receiving . . . a plurality of different implementations of at least one of the items of
15 content, where each implementation of any given item of content corresponds to a
16 different set of device capabilities" This limitation was cited by the examiner in
17 the reasons for allowance as being missing from the prior art of record.

18 37. More than one year before this Provisional Application was filed,
19 Ellipsus, which was acquired by Unwired Planet before the '790 Patent's earliest
20 priority date, had offered for sale and put into public use the Ellipsus Products, each of
21 which involved and disclosed each element of at least one claim of the '790 Patent.

22 38. For example, the Ellipsis Products are described in the following
23 publications, each of which was published before June 28, 2001:

- 24 • White Paper – infiniteMASS, Ellipsus' Mobile Application Server Suite (*see*
25 Exhibit 1);
- 26 • White Paper – EAA, Ellipsus' EAA (*see* Exhibit 2); and
- 27 • Ellipsus System Unveils First 100%-Java Wireless Web Services Platform
28 (June 2001 press release) (*see* Exhibit 3).

1 On information and belief, user manuals, technical support documents and other
2 documents related to the infiniteMAP, the infiniteMASS, and the EAA systems.

3 39. Neither infiniteMASS nor EAA, nor any of the publications named above,
4 are disclosed anywhere on the face of the '790 Patent or in the patent's prosecution
5 history.

6 40. Each of the infiniteMASS and EAA systems is prior art to the '790 Patent
7 under 35 U.S.C. §§ 102(a) and 102(b). Each of the publications named above is prior
8 art to the '790 Patent under 35 U.S.C. §§ 102(a) and 102(b).

9 41. Each of the infiniteMASS and EAA systems is material prior art to the
10 '790 Patent and is not cumulative of any prior art of record. Each of the publications
11 named above is material prior art to the '790 Patent and is not cumulative of any prior
12 art of record.

13 42. On information and belief, the examiner of the '790 Patent was not aware
14 of infiniteMASS or EAA, or any of the publications named above relating thereto. On
15 information and belief, the examiner was not aware of the publications named above
16 relating to infiniteMAP (the "withheld infiniteMAP documents"). *See* Exhibit 4. Had
17 the examiner been aware of infiniteMASS or EAA or any of these publications,
18 including the withheld infiniteMAP documents, the examiner would have rejected the
19 claims of the '790 Patent and would not have allowed them to issue, because the
20 infiniteMASS and EAA systems and each of these publications disclosed or rendered
21 obvious each and every limitation of the claims of the '790 Patent.

22 43. For example, with respect to Claim 1 of the '790 Patent, infiniteMASS
23 and EAA performed methods of providing access to content for use in wireless
24 communication devices, including receiving and storing a plurality of different
25 implementations of at least one of the items of content, where each implementation of
26 any given item of content corresponds to a different set of device capabilities, and
27 maintaining a product catalog containing a description of the items of content with a
28 reference to each implementation of said item of content. Had the examiner been

1 aware of infiniteMASS, EAA, or any of the publications named above, the examiner
2 would have rejected Claim 1 under 35 U.S.C. §§ 102 and 103.

3 44. On information and belief, the withheld infiniteMAP documents disclose
4 the method of providing access to content for use in wireless communication devices,
5 including receiving and storing a plurality of different implementations of at least one
6 of the items of content, where each implementation of any given item of content
7 corresponds to a different set of device capabilities, and maintaining a product catalog
8 containing a description of the items of content with a reference to each
9 implementation of said item of content. Had the examiner been aware of the withheld
10 infiniteMAP documents, the examiner would have rejected Claim 1 under 35 U.S.C.
11 §§ 102 and 103.

12 45. On information and belief, individuals associated with prosecution of the
13 '790 Patent, including at least named inventor Rikard M. Kjellberg, withheld the
14 infiniteMASS and EAA prior art (including Ellipsus's offers for sale and public use of
15 these systems) from the examiner, with intent to deceive the USPTO. On information
16 and belief, Mr. Kjellberg withheld the withheld infiniteMAP documents from the
17 examiner with intent to deceive the USPTO.

18 46. Mr. Kjellberg was a co-founder of Ellipsus Systems and a co-author of the
19 infiniteMASS and EAA white papers.

20 47. Mr. Kjellberg therefore knew that the infiniteMASS and EAA systems,
21 and each of the publications named above, including the withheld infiniteMAP
22 documents, were prior art to, and disclosed the limitations of the claims of, the
23 application for the '790 Patent. Yet Mr. Kjellberg did not disclose the infiniteMASS
24 and EAA systems, or any of the publications named above, including the withheld
25 infiniteMAP documents, to the examiner of the '790 Patent.

26 48. During prosecution of the '033 Patent, with regards to a similar white
27 paper on Ellipsus's infiniteMAP product, Mr. Kjellberg and the other applicants of the
28 '033 Patent stated that as a result of Unwired Planet's acquisition of Ellipsus,

1 “[Unwired Planet is] thoroughly familiar with the product disclosed in the
2 [infiniteMAP white paper] and are more-than-qualified to comment on the extent of
3 that reference’s disclosure.” Amendment dated July 18, 2006. Mr. Kjellberg’s claim
4 of thorough familiarity with infiniteMAP demonstrates his knowledge of the withheld
5 infiniteMAP documents.

6 49. On information and belief, Mr. Kjellberg withheld from the examiner of
7 the ’790 Patent the infiniteMASS and EAA systems and each of the publications
8 named above, including the withheld infiniteMAP documents, with intent to deceive
9 the USPTO. On information and belief, Mr. Kjellberg knew that had the examiner
10 been aware of the withheld art, the examiner would have rejected the claims of the
11 application for the ’790 Patent and would not have allowed those claims to issue.

12 50. Thus, by withholding the infiniteMAP and EAA systems, and each of the
13 publications named above, from the examiner, Mr. Kjellberg deceived the examiner
14 and the USPTO in order to obtain issuance of the ’790 Patent.

15 51. Because of the inequitable conduct committed by Mr. Kjellberg in
16 connection with the ’790 Patent, the ’790 Patent is unenforceable, and Unwired Planet
17 may not obtain any relief regarding it.

18 **U.S. Patent No. 7,020,685**

19 52. During prosecution of the ’685 Patent, Unwired Planet and individuals
20 associated with prosecution of the patent withheld material, non-cumulative prior art
21 from the patent examiner with intent to deceive the USPTO. This material prior art
22 included Unwired Planet’s own commercial activity, printed publications relating to
23 that activity, and at least one prior art patent reference, as described below.

24 53. The ’685 Patent states on its face that it issued from U.S. Patent
25 Application No. 09/640,902, filed on August 16, 2000. The ’685 Patent also states that
26 it is related to Provisional Application No. 60/158,694, filed on October 8, 1999.

27 *UP.Link and PocketNet*

28 54. More than one year before the Provisional Application to the ’685 Patent

1 was filed, Unwired Planet had offered for sale and put into public use the UP.Link and
2 PocketNet systems, each of which involved and disclosed each element of at least one
3 claim of the '685 Patent.

4 55. The UP.Link and/or PocketNet systems are described in the following
5 exemplary publications, each of which was published before October 8, 1998:

- 6 • UP.Link Developer's Guide, Version 1.0 (*see* Exhibit 5);
- 7 • Using the UP.Browser, Version 1.01 (*see* Exhibit 6);
- 8 • HDTP Specification, Version 1.1 (*see* Exhibit 7);
- 9 • Unwired Planet Announces UP.Link Platform 2.0 (press release dated July 8,
10 1997) (*see* Exhibit 8);
- 11 • Unwired Planet Brings the Web to Cellular Telephones and Pagers (press
12 release dated July 15, 1996) (*see* Exhibit 9);
- 13 • Using UP.Mail (July 1997) (*see* Exhibit 10); and
- 14 • Developing Applications for the PocketNet Phone (1996 White Paper) (*see*
15 Exhibit 11).

16 Collectively, the UP.Link and PocketNet systems, including any publications
17 describing those systems, will be referred to herein as the "UP.Link and PocketNet
18 Prior Art."

19 56. None of the UP.Link and PocketNet Prior Art is disclosed anywhere on
20 the face of the '685 Patent or in its prosecution history.

21 57. The UP.Link and PocketNet Prior Art is prior art to the '685 Patent under
22 35 U.S.C. §§ 102(a) and 102(b). The UP.Link and/or PocketNet systems, and/or each
23 of the publications named above, is prior art to the '685 Patent under 35 U.S.C. §§
24 102(a) and 102(b).

25 58. Each of the UP.Link and PocketNet Prior Art is material prior art to the
26 '685 Patent and is not cumulative of any prior art of record. Each of the publications
27 named above is material prior art to the '685 Patent and is not cumulative of any prior
28 art of record.

1 59. On information and belief, the examiner of the '685 Patent was not aware
2 of the UP.Link and PocketNet Prior Art. Had the examiner been aware of the UP.Link
3 and PocketNet Prior Art, the examiner would have rejected the claims of the '685
4 Patent and would not have allowed them to issue, because the UP.Link and PocketNet
5 Prior Art disclosed or rendered obvious each and every limitation of the claims of the
6 '685 Patent.

7 60. For example, with respect to Claim 1 of the '685 Patent, UP.Link and
8 PocketNet performed methods of providing content from a network to a wireless
9 device, including retrieving content from a resource on a network according to a
10 hypermedia protocol with which the wireless device was not compliant, and converting
11 the content to a message compliant with a message requirement of the wireless device.
12 As explained by the UP.Link Developer's Guide, the UP.Link system retrieved
13 network content using the HTTP protocol, with which UP.Phone wireless devices were
14 not compliant. Then the UP.Link system converted the retrieved content to a message
15 compliant with UP.Phone wireless devices. *See, e.g.*, Exhibit 5 (UP.Link Developer's
16 Guide, v. 1.0) at v. *See also* Exhibit 11 (Developing Applications for the PocketNet
17 Phone, 1996 White Paper) at 3 (showing "PocketNet Information Flow" in which an
18 "UPLink [sic] Gateway" retrieves network content using the HTTP protocol and then
19 converts the retrieved content to a "HDML Command" message compliant with
20 "UPLink-enabled Phone[s]").

21 61. Had the examiner been aware of the UP.Link and PocketNet Prior Art, the
22 examiner would have rejected Claim 1 under 35 U.S.C. §§ 102 and 103, because the
23 UP.Link and PocketNet Prior Art disclosed or rendered obvious each and every
24 limitation of Claim 1.

25 62. On information and belief, individuals associated with prosecution of the
26 '685 Patent, including at least named inventor David A. Chen and prosecution counsel
27 Jordan Becker, withheld the UP.Link and PocketNet Prior Art (including Unwired
28 Planet's offers for sale and public use of these systems) from the examiner of the

1 application for the '685 Patent, with intent to deceive the USPTO.

2 63. On information and belief, Mr. Chen was employed by Unwired Planet at
3 least as early as April 1998, more than one year before the filing of the Provisional
4 Application to which the '685 Patent purports to claim priority. On information and
5 belief, Mr. Chen was a Senior Product Manager for Unwired Planet's Mobile Browser
6 business, and was involved in Unwired Planet's prior-art commercial activity including
7 the sale, offer for sale, or public use of the UP.Link or PocketNet Systems or related
8 systems. For example, a page on the website LinkedIn regarding Mr. Chen states that
9 he "[d]rove mobile browser product through company's [Unwired Planet's] first
10 volume rollout across multiple handset OEMs and US and Japanese wireless
11 operators" and "[l]ed production of industry's first WAP-standard mobile browser for
12 worldwide use." *See* Exhibit 12, <http://www.linkedin.com/profile/view?id=2045186>
13 (last visited Nov. 27, 2012).

14 64. On information and belief, Mr. Chen knew about the UP.Link and
15 PocketNet Prior Art because of his work on Unwired Planet's Mobile Browser
16 business, and knew that they were prior art to, and disclosed the limitations of the
17 claims of, the application for the '685 Patent. Yet Mr. Chen did not disclose the
18 UP.Link and PocketNet Prior Art to the examiner of the '685 Patent.

19 65. Mr. Becker prosecuted multiple patent applications for Unwired Planet,
20 including several other applications that were pending before or during the pendency
21 of the '685 Patent. Those other applications included applications that related to
22 Unwired Planet's Mobile Browser business, including to the UP.Link and PocketNet
23 systems. On information and belief, Mr. Becker knew about the UP.Link and
24 PocketNet Prior Art at least via his work on patent applications filed by Unwired
25 Planet, and knew that they were prior art to, and disclosed the limitations of the claims
26 of, the application for the '685 Patent. Yet Mr. Becker did not disclose the UP.Link
27 and PocketNet Prior Art to the examiner of the '685 Patent.

28 66. For example, Mr. Becker was involved in prosecution of U.S. Patent No.

1 6,742,127, entitled “Method and Apparatus for Maintaining Security in a Push
2 System” (“the ’127 Patent”). The ’127 Patent issued to Unwired Planet’s predecessor
3 Openwave Systems, Inc. on May 25, 2004, while the ’685 Patent was still pending.
4 The ’127 Patent discusses an “UP.Link Gateway” that converts between hypermedia
5 formats. *See, e.g.*, ’127 patent, Fig. 1, col. 4:4-13. On information and belief, Mr.
6 Becker was aware of the “UP.Link Gateway” disclosed in the ’127 Patent (which he
7 was involved in prosecuting), was aware that it related to Unwired Planet’s UP.Link
8 system, and was aware that the UP.Link system was on sale and in public use before
9 October 8, 1998.

10 67. For further example, Mr. Becker was involved in the prosecution of U.S.
11 Patent No. 6,665,711, entitled “Method and Apparatus for Integrating Narrowband and
12 Wideband Data Transports” (“the ’711 Patent”). The ’711 Patent issued to Unwired
13 Planet’s predecessor Openwave Systems, Inc. on December 16, 2003, while the ’685
14 Patent was still pending. The ’711 Patent discusses the UP.Link Gateway and also
15 discusses a wireless device obtaining access to information from
16 “www.att.com/PocketNet.” *See, e.g.*, ’711 Patent, Fig. 1, col. 9:5-6. On information
17 and belief, Mr. Becker was aware of the PocketNet discussion in the ’711 Patent
18 (which he was involved in prosecuting), was aware that it related to Unwired Planet’s
19 commercial activity regarding the PocketNet system, and was aware that the
20 PocketNet system was on sale and in public use before October 8, 1998.

21 68. On information and belief, both Mr. Becker and Mr. Chen withheld
22 from the examiner of the ’685 Patent the UP.Link and PocketNet systems and each of
23 the publications named above with intent to deceive the USPTO. On information and
24 belief, Mr. Becker and Mr. Chen each knew that had the examiner been aware of the
25 UP.Link and PocketNet Prior Art, the examiner would have rejected the claims of the
26 application for the ’685 Patent and would not have allowed those claims to issue.

27 69. For example, the examiner of the ’685 Patent repeatedly rejected all
28 claims over U.S. Patent No. 6,473,609 (“the ’609 Patent”), explaining that the ’609

1 Patent discloses or renders obvious (in combination with other references) all
2 limitations of the claims of the application for the '685 Patent. *See* U.S Patent
3 Application 09/640,902, Office Actions dated November 14, 2003, and April 26, 2004.
4 In response, Unwired Planet (in filings by Mr. Becker) represented to the examiner that
5 the '609 Patent was not prior art to the application for the '685 Patent because the
6 subject matter was owned by or subject to an obligation of assignment to the same
7 person (Unwired Planet's predecessor Phone.com) at the time of the alleged invention.
8 *See id.*, Amendments dated February 17, 2004, and June 17, 2004. The examiner then
9 withdrew the rejections for anticipation and obviousness, and instead issued a rejection
10 for double patenting over the '609 Patent. *See id.*, Office Action dated July 29, 2004.
11 Unwired Planet was able to overcome this double-patenting rejection by filing a
12 terminal disclaimer, resulting in a notice of allowance. *See id.*, Amendment and
13 Terminal Disclaimer dated August 10, 2004 and Notice of Allowance dated October 7,
14 2004.

15 70. Had the examiner been informed about the UP.Link and PocketNet Prior
16 Art, the examiner would have rejected the claims of the '685 Patent over that art as
17 well, as it disclosed the very same limitations that the examiner found disclosed by the
18 '609 Patent. And Unwired Planet would not have been able to rely on the common-
19 ownership provision of the Patent Act to overcome such a rejection. For example, the
20 examiner's November 14, 2003 rejection explained that the '609 Patent discloses a
21 "method of providing content from a network to a wireless device" including the steps
22 of "receiving the content from a resource on the network according to a hypermedia
23 protocol, wherein the wireless device is not compliant with the hypermedia protocol,"
24 and "converting the content to a message compliant with a message requirement of the
25 wireless device." *Id.* at 2. As explained above, the UP.Link and PocketNet systems
26 disclosed these very same limitations. For example, the UP.Link Developer's Guide
27 explains that the UP.Link system retrieved network content via the HTTP protocol and
28 converted the content to a message compliant with message requirements of UP.Link

1 Phone wireless devices.

2 71. The common-ownership provision does not exempt art that qualifies
3 under section 102(b), including prior public use, offers for sale, and printed
4 publications such as the UP.Link and PocketNet Prior Art. *See* 35 U.S.C. § 103(c).

5 72. Thus, by withholding the UP.Link and PocketNet Prior Art from the
6 examiner, Mr. Becker and Mr. Chen deceived the examiner into allowing claims that
7 should not have been allowed, and deceived the USPTO into issuing the '685 Patent.
8 On information and belief, Mr. Becker and Mr. Chen withheld the UP.Link and
9 PocketNet Prior Art with intent to so deceive the examiner and the USPTO.

10 *U.S. Patent 6,094,587 ("Armanto")*

11 73. United States Patent No. 6,094,587 ("Armanto") is prior art to the '685
12 Patent under 35 U.S.C. § 102(e). *See* Exhibit 13.

13 74. Armanto discloses a method of sending a ringtone to a wireless device by
14 converting the ringtone into an SMS message and sending the SMS message to the
15 wireless device.

16 75. Armanto is not cited on the face of the '685 Patent or in the prosecution
17 history of the '685 Patent.

18 76. Armanto is material to the claims of the '685 Patent, and is not cumulative
19 of the art of record.

20 77. On information and belief, the examiner of the '685 Patent was not aware
21 of Armanto. Had the examiner been aware of Armanto, the examiner would have
22 rejected the claims of the '685 Patent and would not have allowed them to issue,
23 because Armanto disclosed or rendered obvious each and every limitation of the
24 claims of the '685 Patent.

25 78. For example, Armanto discloses the following element of Claim 1 of the
26 '685 Patent, which Unwired Planet contended was a distinction over the prior art:
27 converting the content to a message compliant with a message requirement of the
28 wireless device, including generating a message including the content. *See, e.g.,*

1 Exhibit 13 (Armanto), Abstract (disclosing a method in which a “ringing tone is
2 transformed into characters containing specifications of notes and the characters are
3 sent to the telephone, e.g., in a short message”). Had the examiner been aware of
4 Armanto, the examiner would have rejected Claim 1 under 35 U.S.C. §§ 102 and 103.

5 79. On information and belief, individuals associated with the prosecution of
6 the ’685 Patent, including at least named inventor David A. Chen and prosecution
7 counsel Jordan Becker, withheld Armanto from the examiner of the application for the
8 ’685 Patent with intent to deceive the USPTO.

9 80. Mr. Becker was aware of Armanto by the time that that Mr. Becker was
10 prosecuting the application that issued as the ’685 Patent. For example, Mr. Becker
11 submitted Armanto to the USPTO as part of an Information Disclosure Statement filed
12 by Mr. Becker on November 4, 1995 in the prosecution of U.S. Patent App. No.
13 09/999,656.

14 81. Despite having been aware of Armanto and having submitted it to the
15 USPTO in connection with a different patent application, Mr. Becker did not submit
16 Armanto to the USPTO in connection with the prosecution of the ’685 Patent.

17 82. On information and belief, Mr. Becker was aware that Armanto was
18 material to the application for the ’685 Patent, and withheld Armanto from the
19 examiner with intent to deceive the examiner and the USPTO into allowing the ’685
20 Patent to issue when it should not have been allowed.

21 83. On information and belief, Mr. Chen was also aware of Armanto, for
22 example from Mr. Becker’s submission of Armanto to the USPTO in connection with
23 the prosecution of U.S. Patent App. No. 09/999,656, on which Mr. Chen was named as
24 an inventor. On information and belief, Mr. Chen was aware that Armanto was
25 material to the application for the ’685 Patent, and withheld Armanto from the
26 examiner with intent to deceive the examiner and the USPTO into allowing the ’685
27 Patent to issue when it should not have been allowed.

28 84. Because of the inequitable conduct committed by Mr. Chen and Mr.

1 Becker in connection with the '685 Patent, the '685 Patent is unenforceable, and
2 Unwired Planet may not obtain any relief regarding it.

3 **U.S. Patent No. 6,647,260**

4 85. During prosecution of the '260 Patent, Unwired Planet and individuals
5 associated with prosecution of the patent withheld material, non-cumulative prior art
6 from the patent examiner with intent to deceive the USPTO. This material prior art
7 included Unwired Planet's own commercial activity, printed publications relating to
8 that activity, and at least one prior art patent reference, as described below.

9 86. The '260 Patent states on its face that it issued from U.S. Patent
10 Application No. 09/289,559, filed on April 9, 1999.

11 *UP.Link and PocketNet*

12 87. More than one year before this application was filed, Unwired Planet had
13 offered for sale and put into public use the UP.Link and PocketNet systems, each of
14 which involved and disclosed each element of at least one claim of the '260 Patent.

15 88. For example, the UP.Link and/or PocketNet systems are described in the
16 following publications, each of which was published before April 9, 1998:

- 17 • UP.Link Developer's Guide, Version 1.0 (*see* Exhibit 5);
- 18 • Using the UP.Browser, Version 1.01 (*see* Exhibit 6);
- 19 • HDTP Specification, Version 1.1 (*see* Exhibit 7);
- 20 • Unwired Planet Announces UP.Link Platform 2.0 (press release dated July 8,
21 1997) (*see* Exhibit 8);
- 22 • Unwired Planet Brings the Web to Cellular Telephones and Pagers (press
23 release dated July 15, 1996) (*see* Exhibit 9);
- 24 • Using UP.Mail (July 1997) (*see* Exhibit 10); and
- 25 • Developing Applications for the PocketNet Phone (1996 White Paper) (*see*
26 Exhibit 11).

27 Collectively, the UP.Link and PocketNet systems, including any publications
28 describing those systems, will be referred to herein as the "UP.Link and PocketNet

1 Prior Art.”

2 89. None of the UP.Link and PocketNet Prior Art is disclosed anywhere on
3 the face of the '260 Patent or in its prosecution history. Neither the UP.Link or
4 PocketNet systems, nor any of the publications named above, is disclosed anywhere on
5 the face of the '260 Patent or in its prosecution history.

6 90. Each of the UP.Link and PocketNet Prior Art is prior art to the '260
7 Patent under 35 U.S.C. §§ 102(a) and 102(b). Each of the publications named above is
8 prior art to the '260 Patent under 35 U.S.C. §§ 102(a) and 102(b).

9 91. Each of the UP.Link and PocketNet Prior Art is material prior art to the
10 '260 Patent and is not cumulative of any prior art of record. Each of the UP.Link and
11 PocketNet systems, and each of the publications named above, is material prior art to
12 the '260 Patent and is not cumulative of any prior art of record.

13 92. On information and belief, the examiner of the '260 Patent was not aware
14 of the UP.Link or PocketNet Prior Art. Had the examiner been aware of the UP.Link
15 or PocketNet Prior Art, the examiner would have rejected the claims of the '260 Patent
16 and would not have allowed them to issue, because the UP.Link and PocketNet Prior
17 Art disclosed or rendered obvious each and every limitation of the claims of the '260
18 Patent.

19 93. For example, with respect to Claim 1 of the '260 Patent, UP.Link and
20 PocketNet performed methods of provisioning a two-way mobile communications
21 device having a display and a user interface, with the mobile communications device
22 receiving user information, displaying a list of selectable identifiers on the display,
23 receiving a user's selection of an identifier, generating a provisioning request
24 comprising the user information and the selection, establishing a communication link
25 and authenticating with a remote server, sending the provisioning request to the
26 provisioning server, receiving a reply, and provisioning the two-way communications
27 device with a feature or service based on the reply. Had the examiner been aware of
28 the UP.Link and PocketNet Prior Art, the examiner would have rejected Claim 1 under

1 35 U.S.C. §§ 102 and 103.

2 94. On information and belief, individuals associated with prosecution of the
3 '260 Patent, including at least named inventors Peter F. King, Bruce V. Schwartz, and
4 Bruce K. Martin, Jr., withheld the UP.Link and PocketNet Prior Art (including
5 Unwired Planet's offers for sale and public use of these systems) from the examiner of
6 the application for the '260 Patent, with intent to deceive the USPTO.

7 95. On information and belief, Mr. King was employed by Openwave
8 Systems and its precursors Phone.com and Unwired Planet at least as early as 1995,
9 more than one year before the filing of the Application which led to the '260 Patent.
10 On information and belief, Mr. King was Director of Technology of Openwave, and
11 was involved in Unwired Planet's prior-art commercial activity including the sale,
12 offer for sale, or public use of the UP.Link or PocketNet Systems or related systems.
13 On information and belief, Mr. King knew about the UP.Link and PocketNet Prior Art
14 because of his work on Openwave's Mobile Browser business, including UP.Link
15 specifically, and because he was in charge of managing Unwired Planet's patent
16 process in 1997 and 1998, and knew that they were prior art to, and disclosed the
17 limitations of the claims of, the application for the '260 Patent. On information and
18 belief, Mr. King was particularly aware of the HDTP Specification 1.0 (*see* Exhibit 7)
19 because he authored it. Yet Mr. King did not disclose the UP.Link and PocketNet
20 Prior Art to the examiner of the '260 Patent.

21 96. On information and belief, Mr. Schwartz was employed by Openwave
22 Systems and its precursors Phone.com and Unwired Planet at least as early as
23 November 1994, more than one year before the filing of the Application which led to
24 the '260 Patent. On information and belief, Mr. Schwartz was Co-Founder of
25 Phone.com and a Member of Technical Staff at Phone.com and Openwave, and was
26 involved in Unwired Planet's prior-art commercial activity including the sale, offer for
27 sale, or public use of the UP.Link or PocketNet Systems or related systems. On
28 information and belief, Mr. Schwartz knew about the UP.Link and PocketNet Prior Art

1 because of his work on Openwave's Mobile Browser business, and knew that they
2 were prior art to, and disclosed the limitations of the claims of, the application for the
3 '260 Patent. Yet Mr. Schwartz did not disclose the UP.Link and PocketNet Prior Art
4 to the examiner of the '260 Patent.

5 97. On information and belief, Mr. Martin was employed by Openwave
6 Systems and its precursors Phone.com and Unwired Planet at least as early as 1995,
7 more than one year before the filing of the Application which led to the '260 Patent.
8 On information and belief, Mr. Martin was Chief Technology Officer of Openwave,
9 and was involved in Unwired Planet's prior-art commercial activity including the sale,
10 offer for sale, or public use of the UP.Link or PocketNet Systems or related systems.
11 On information and belief, Mr. Martin knew about the UP.Link and PocketNet Prior
12 Art because of his work on Openwave's Mobile Browser business, and knew that they
13 were prior art to, and disclosed the limitations of the claims of, the application for the
14 '260 Patent. Yet Mr. Martin did not disclose the UP.Link and PocketNet Prior Art to
15 the examiner of the '260 Patent.

16 98. On information and belief, Messrs. King, Schwartz, and Martin
17 withheld from the examiner of the '260 Patent the UP.Link and PocketNet Prior Art
18 with intent to deceive the USPTO. On information and belief, Messrs. King,
19 Schwartz, and Martin each knew that had the examiner been aware of the UP.Link and
20 PocketNet Prior Art, the examiner would have rejected the claims of the application
21 for the '260 Patent and would not have allowed those claims to issue.

22 99. For example, the examiner of the '260 Patent initially rejected all claims
23 over U.S. Patent No. 6,031,830 ("the '830 Patent"), explaining that the '830 Patent
24 discloses or renders obvious (in combination with other references) all limitations of
25 the claims of the application for the '260 Patent. *See* U.S Patent Application
26 09/289,559, Office Action dated July 31, 2001. In response, Unwired Planet
27 represented to the examiner that the limitation of the '260 Patent whereby the user
28 input is received by the device was not present in the '830 Patent. Similarly, the

1 examiner of the '260 Patent then rejected all claims over U.S. Patent No. 5,812,953
2 ("the '953 Patent"), explaining that the '953 Patent discloses or renders obvious (in
3 combination with other references) all limitations of the claims of the application for
4 the '260 Patent. *See* U.S Patent Application 09/289,559, Office Action dated January
5 16, 2002. In response, Unwired Planet represented to the examiner that the limitation
6 of the '260 Patent whereby the selections available to the user are displayed and the
7 user selects one of the displayed selections was not present in the '953 Patent.

8 100. Based on Unwired Planet's representations as to the prior art's missing
9 limitations, the examiner allowed the '260 Patent to issue. Had the examiner been
10 informed about the UP.Link and PocketNet Prior Art, the examiner would have
11 rejected the claims of the '260 Patent over that prior art, as it disclosed the very same
12 limitations that Unwired Planet argued were not present in the '830 or '953 patents.
13 The UP.Link and PocketNet phones, for example, clearly disclosed receiving user
14 input by the device, which Unwired Planet argued was missing from the '830 Patent,
15 since UP.Link and PocketNet phones displayed users a list of choices which could be
16 selected. *See* Exhibit 5 (UP.Link Developer's Guide, v. 1.0) at 25. Similarly, UP.Link
17 and PocketNet phones disclosed displaying selections and receiving a selection of
18 those displayed, which Unwired Planet argued was missing from the '953 Patents,
19 when displaying lists of choices to the user for selection. *Id.*

20 101. Thus, by withholding the UP.Link and PocketNet Prior Art from the
21 examiner, Messrs. King, Schwartz, and Martin deceived the examiner into allowing
22 claims that should not have been allowed, and deceived the USPTO into issuing the
23 '260 Patent. On information and belief, Messrs. King, Schwartz, and Martin withheld
24 the UP.Link and PocketNet Prior Art with intent to so deceive the examiner and the
25 USPTO.

26 102. Because of the inequitable conduct committed by Messrs. King,
27 Schwartz, and Martin in connection with the '260 Patent, the '260 Patent is
28 unenforceable, and Unwired Planet may not obtain any relief regarding it.

* * *

103. Pursuant to 28 U.S.C. § 2201(a), and as a result of Unwired Planet's allegations of infringement against Apple, an actual and justiciable controversy has arisen and exists between Apple and Unwired Planet. Apple is entitled to a judicial determination and declaration that it has not infringed and is not infringing the Asserted Patents and that the Asserted Patents are invalid and unenforceable.

104. On information and belief, when Unwired Planet brought this action, it knew, or should have known, that the claims of the Asserted Patents are invalid and that Apple has not infringed and does not infringe any valid and enforceable claim of the Asserted Patents.

105. This counterclaim presents exceptional circumstances within the meaning of 35 U.S.C. § 285, and Apple is thus entitled to an award of its reasonable attorneys' fees.

DEMAND FOR JURY TRIAL

Apple demands a jury trial on all of its Counterclaims and on all other issues that may be tried by a jury.

WHEREFORE, Defendant and Counterclaimant Apple prays as follows:

A. That the Complaint against Apple be dismissed in its entirety with prejudice and that a judgment be entered in favor of Apple and against Unwired Planet;

B. That Unwired Planet take nothing by reason of its Complaint;

C. That the Court enter an order denying any and all of Unwired Planet's requests for injunctive relief against Apple;

D. That the Court enter a judgment declaring that Apple has not infringed and does not infringe, directly, contributorily or by inducement, any claim of the Asserted Patents;

E. That the Court enter a judgment declaring that each and every claim of the Asserted Patents is invalid;

1 F. That the Court enter a judgment declaring that the '033, '790, '685, and
2 '260 Patents are unenforceable;

3 G. That the Court enter an order under 35 U.S.C. § 285, awarding Apple its
4 reasonable attorneys' fees and costs of suit incurred in this litigation, as Unwired
5 Planet's conduct as set forth above renders this an exceptional case; and

6 H. That the Court enter an order awarding Apple all such other and further
7 relief as the Court deems proper.

8 Dated: this 29th day of November, 2012.

9 By: /s/ Jonathan W. Fountain

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28

CERTIFICATE OF SERVICE

I, hereby certify that on November 29, 2012, I filed a true and accurate copy of the foregoing document entitled, ANSWER TO COMPLAINT FOR PATENT INFRINGEMENT, AFFIRMATIVE AND OTHER DEFENSES, AND COUNTERCLAIM, with the Clerk of the Court via the Court's CM/ECF system, which will send electronic notice of the same to the following CM/ECF participants:

- Theodore Stevenson III (tstevenson@mckoolsmith.com);
- Kevin L. Burgess (kburgess@mckoolsmith.com);
- Pierre J. Hubert (phubert@mckoolsmith.com);
- Michael D. Rounds (mrounds@watsonrounds.com); and
- Adam K. Yowell (ayowell@watsonrounds.com)

Dated: this 29th day of November, 2012.

/s/ Jonathan W. Fountain
An employee of Lewis and Roca LLP